

REMARKS

In the Official Action of February 8, 2001, the Examiner rejected Claims 1-22 and 24-28 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. In particular, the rejection referred to such terms as "approaching the size of or greater than" and "approaching that of or exceeding that of" as having no clear meaning. While applicant does not agree with this as there is a reasonable interpretation when considering the term "approaching" a baseball in relation to a golf ball, which is the relationship disclosed and taught by the application. Granted, there is no precise dimension or weight recited in the claims when using the term "approaching," but it is clearly understandable that it would be a weight and size generally similar to that of a baseball and substantially different from the size and weight of the golf ball. It is submitted that this is well within accepted practice for defining the characteristics of an element in the claim. However, to expedite prosecution of the claims of the present application, applicant has amended rejected independent Claims 1 and 24 to eliminate the "approaching" language and substitute the term "at least that of." As Claims 2-22 depend from Claim 1, the amendment applies to them by reference.

The present invention is directed to a golf practice device for use with a golf club for the dual purpose of practicing golf swing techniques and for exercising the muscles used in swinging a golf club. This is accomplished by using an object sufficiently larger than a golf ball, such as a baseball, so that free swinging can be developed without having to concentrate on hitting a small object, such as a golf ball, with the large object providing sufficient resistance for exercising the muscles used in the golf swing while allowing the user to swing the golf club through a full follow-through.

There are a number of prior devices used by golfers to practice to improve their swing. The ones that allow a full swing after striking the object use golf balls or objects that are the size of a golf ball, which provide little muscle-building resistance and require the golfer to concentrate on striking a small object rather than swinging freely to practice swing techniques. There is also the Impact Bag that is of sufficient mass that it stops the golf swing without a follow-through so that the golf club is stopped at approximately where the club would strike a golf ball and the golfer can then evaluate his ball-striking position. However, this alternative does not allow the swing to be completed so that the complete swing technique can be practiced and does not necessarily require striking with a force sufficient for muscle building as is the case when the object allows the club to be swung through a full follow-through.

In contrast, in the preferred embodiment of the present invention, as recited in Claim 1, an object is swingably suspended from the arm of a frame with the object having an impact surface of a size at least that of the corresponding surface of a baseball to provide a large target so that the golfer can swing freely without concentration on striking a small object, and the object is of a mass at least that of a baseball to provide substantial resistance to the impact of a golf club to impose muscular strain on the golfer for muscle development but being limited in mass to allow the head of the golf club to swing the object sufficiently for the clubhead to ultimately pass under the object and allow the golfer to complete a full follow-through of the golf swing.

Claim 24 is directed to the same features as Claim 1, but with the object resting on the ground and having an impact surface and mass at least that of a softball.

The present invention is specifically directed to the game of golf and to improving the swing technique and the strength of a golfer. This is emphasized in the amended preamble and the amended body of independent Claims 1 and 24. The Supervisory Examiner stated that the

preamble of Claims 1 and 24 prior to amendment was not a limitation and, therefore, the structural elements of the claims were found in the prior art in relation to non-golf practice devices. To overcome this basis for rejection, applicant has presently amended the claims to recite in the preamble that the golf practice and exercise device is for use with a golf club, and has amended the body of the claims to recite that the object is in position to be struck during a normal swing of the golf club, that the large target is provided so that the golf club can be swung freely without concentration on striking the small target of a golf ball.

It is submitted that, with these amendments, the claims are limited to a golf practice and exercise device for use with a golf club, as stated in the preamble and as emphasized in the body of the claims. This conforms with the legal precedents for the type claims in which the preamble is considered a limitation.

Where a preamble provides antecedent bases for terms found in the body of the claim, which is the case here, or where the preamble ties the body of the claim to a specific problem explicitly defined in the specification, which the case here, or where the language in the preamble was included to overcome prior art, which is the case here, the preamble is considered a limitation of the claim.

This preamble limitation issue was the subject of the oft-quoted case of *Kropa v. Robie*, 88 U.S.P.Q. 478 (CCPA 1951). While formulating a ruling in the case, the Court reviewed its past rulings concerning the preamble of a claim. *See id.* at 480. The Court determined that the preamble was considered a limitation when the preamble “was deemed essential to point out the invention defined by the claim,” whereby the preamble was needed to “give life, meaning, and vitality to the claims.” *Id.* at 480-81. In many of the previous cases in which the preamble was found to be a limitation, the preamble tied the body of the claim to a specific problem defined in the specification and for which a solution had evaded prior inventors. *See id.* at 481.

The Court then observed that in the previous cases where the preamble was not considered a limitation the claim body had a completely self-contained description of the subject matter of the invention and the preamble merely stated the purpose or intended use of the invention. *See id.* at 480.

In another, oft-quoted case, *Bell Communications Research v. Vitalink Communications Corp.*, 34 U.S.P.Q.2d 1816 (Fed. Cir. 1995), the Court refused to apply an absolute and mechanical rule to determine the effect of the preamble. *See id.* at 1821 (“[O]ne cannot determine a preamble’s effect except by reference to the specific claim of which it is a component.”). The Court continued by stating that the “preamble has the import that the claim as a whole suggests for it.” *Id.* at 1820. In this infringement case, the patent contained a claim with the following preamble, “[a] method for transmitting a packet over a system . . . said packet including a source address and a destination address, and said method comprising.” *See id.* at 1818. The term “packet” was then referred to in the body of the claim, using the preamble as antecedent basis for the term. In accusing Vitalink of infringing the patent, Bell argued that the preamble could not be used as a limitation. *See id.* at 1821. The Court disagreed, finding that when Bell used the term “packet” in the preamble as antecedent basis for its use in the claim body, the preamble was incorporated by reference into the claim. *See id.* Observed the Court, “when the claim drafter chooses to use *both* the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.” *Id.* Another case where the preamble was found to be a limitation because it provided antecedent basis for the claim body is *Pitney Bowes Inc. v. Hewlett-Packard Co.*, 51 U.S.P.Q.2d 1161 (Fed. Cir. 1999) (in this case, however, the claim language was ambiguous).

Finally, in the recent case of *Union Oil Co. v. Atlantic Richfield Co.*, 54 U.S.P.Q.2d 1227 (Fed. Cir. 2000), the issue was whether an allegedly infringed patent was invalid as being

anticipated by prior art. The patent disclosed a type of unleaded gasoline fuel developed specifically for the reduction of automobile tailpipe emissions. *See id.* at 1228. The specification explicitly stated that this was the purpose of the invention. *See id.* at 1231. The alleged infringers countered that the fuel disclosed in the claims was identical to aviation and racing fuels previously disclosed. The validity of the patent hinged on whether the preamble, “[a]n unleaded gasoline fuel suitable for combustion in an automotive engine,” was an additional limitation not included in the prior art. The Court found that the explicit language regarding the purpose of the invention showed that the inventors were attempting to solve a particular problem. *See id.* The Court also noted the extensive discussion of the testing procedures and results listed in the specification, the testing procedures involving the operation of ten different *automobiles*, and observed that the inventors had restricted their patent to fuels suitable for standard passenger automobiles. *See id.* With these observations made, the Court held that the preamble had in fact two limitations – unleaded gasoline and restricted to automotive engines – that were not anticipated by the prior art. *See id.*

It is respectfully submitted that the presently amended claims fit the mold of the foregoing legal precedents.

With regard to the rejection of the claims based on prior art, none of the cited prior art teaches this combination of golf swing technique practice and golf strengthening by the use of an object at least the size of a baseball and having a mass that provides strengthening when used while allowing full follow-through of the golf swing for swing technique practice purposes.

The primary reference relied on in the Official Action in rejecting Claims 24, 25 and 27 under 35 U.S.C. §102(b) is Henderson U.S. Patent No. 1,700,224. This patent teaches the use of a golf ball, not a larger size object, such as a baseball or larger. Thus, this is the type of prior art

mentioned previously over which the presently amended claims specifically define. There is nothing in the Henderson patent to teach or suggest the use of an enlarged object to be struck by a golfer to serve both swing practice and muscle building. The statement in the Official Action that the Henderson golf ball is substantially the same as a baseball/ softball, i.e., both are hard, round, approximately the same size, and both are hit by a club, is no longer applicable to the claims as now amended. Baseball and softball on the one hand and golf on the other hand are totally different activities requiring different swings, and practice balls for prior art baseball or softball practice devices are the same as the balls used in playing the game, whereas the use of a baseball or softball for use in practicing with a golf club is totally different.

In rejecting Claims 1, 2 and 18-21 under 25 U.S.C. §102(b), the Official Action relies on the McLaughlin patent, U.S. Patent No. 1,847,570, but this, like the Henderson patent, discloses and teaches the use of a golf ball in a golf practice device. There is no disclosure or teaching in McLaughlin of the use of a large object so that the device can be used as a combination swing practice and muscle building device for golfers.

The Wallace patent, U.S. Patent No. 6,030,303, relied on specifically during the interview, discloses composite balls of variable weight to allow a tethered ball to be used for a variety of different games. The teaching is of an outer spherical component that is not disclosed as being of different sizes, and an inner component that can be varied in weight and size to provide different characteristics so that the ball can be used for a variety of different games. However, there is no teaching or suggestion in Wallace of using balls of different sizes for practicing a particular game, and particularly no disclosure of using a large ball in place of a golf ball in a golf practice device.

Similarly, the Morgan patent, U.S. Patent No. 4,772,019, while teaching a ball having safety characteristics that can be made in either softball or baseball sizes does not teach or

suggest the use of a ball of a size different than used in playing a particular game, and especially does not teach or suggest the use of an enlarged ball for practicing golf. Morgan suggests only using a softball for practicing softball and a baseball for practicing baseball.

The Kuo patent, U.S. Patent No. 5,330,403 discloses no more than an inflatable punching device, which is disclosed as being used as a punching bag. There is nothing in this reference that teaches a golf practice device using an object larger and heavier than a golf ball to provide for practicing swing techniques with full follow-through without having to concentrate on hitting a small object, while, at the same time providing muscle building exercise.

The Piccini patent, U.S. Patent No. 4,123,053 teaches the use a method for practicing batting against a large cylindrical object. This object is used to stop the bat of the user and prevents follow-through. In this regard, the follow-through of a golf swing is critical to a correct golf swing technique and requires considerable practice to develop the correct swing. This can be accomplished with the present invention while also providing muscle building exercise. This is not taught or suggested in Piccini or any of the other references.

The Critelli patent, U.S. Patent No. 4,527,796, discloses a bag used by boxers and martial arts practitioners. It nowhere teaches or suggests a golf practice device and particularly does not teach or suggest a golf practice device using an object larger than a golf ball so that the user can swing freely through a full follow-through without concentrating on striking a small object, while, at the same time, providing muscle building exercise.

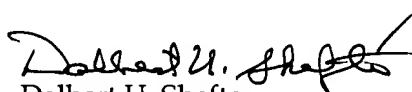
In summary, none of the prior art singly or in combination teaches or suggests a golf practice and exercise device using an object the size of or greater than a baseball so that the user can swing freely for developing swing technique without having to concentrate on striking a small object, while being of a mass of or exceeding that of a baseball to provide substantial resistance to the impact of a golf club to impose muscular strain on the golfer for muscle

development while allowing the user to move the object sufficiently to allow the golfer to complete a full follow-through of the golf swing as claimed in Claims 1-22, and, as claimed in Claim 24, to be of a mass to impose muscular strain on the golfer for muscle development while allowing the user to move the object sufficiently to allow the golfer to complete a full follow-through of the golf swing.

Therefore, it is respectfully submitted that the claims as amended define patentably over the prior art and are in condition for allowance. Reconsideration and allowance of the claims presently pending as amended are respectfully requested.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

Claim 1 has been amended as follows:

1. (Amended) A golf practice and exercise device for use with a golf club, comprising a frame member having a base portion for supporting the device on a floor or ground, said frame member extending upwardly from the base member and having an outwardly extending mounting arm, and an object swingably suspended from said mounting arm with at least a portion of said object adjacent the floor or ground in position to be struck by a golf clubhead during a normal ~~golf~~ swing of said golf club, said object having a golf clubhead impact surface ~~approaching of the~~ a size at least that of ~~or greater than~~ the corresponding surface of a baseball to provide a large target so that the golfer can swing said golf club freely without concentration on striking a ~~the~~ small target of a golf ball, said object being of a mass at least approaching that of or exceeding that of a baseball to provide substantial resistance to the impact of a golf club to impose muscular strain on the golfer for muscle development but being limited in mass to allow the head of the golf club to swing the object sufficiently for the golf clubhead to ultimately pass under the object and allow the golfer to complete the follow-through of the golf swing.

Claim 24 has been amended as follows:

24. (Amended) A golf practice and exercise device for use with a golf club, comprising an object resting on the ground or floor in position for being struck by a golf clubhead during a normal ~~golf~~ swing of said golf club, said object having a golf clubhead impact surface ~~approaching of the~~ a size at least that of ~~or greater than~~ the corresponding surface of a softball to provide a large target so that the golfer can swing said golf club freely

without concentration on striking a the small target of a golf ball, said object being of a mass at least approaching that of or exceeding that of a softball to provide substantial resistance to the impact of a golf club to impose muscular strain on the golfer for muscle development but being limited in mass to allow the head of the golf club to move the object sufficiently to allow the golfer to complete the follow-through of the golf swing, and a flexible cord secured to said object and to the ground or floor to limit the distance said object can move after it has been struck.